

DETAILED ACTION

This application is a 371 of PCT/US04/33473 10/12/2004
which claims benefit of 60/510,097 10/09/2003.

Claims 1-83 are before the Examiner.

See Interview Summary.

In the interview, it was agreed to recast the Restriction/Requirement as follows:

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 77-83, drawn to compounds of formula VIII wherein Y1 is O.

Group 2, claim(s) 77-83, drawn to compounds of formula VIII wherein Y1 is S.

Group 3, claim(s) 1-28 drawn to process of making compounds of formula I.

Group 4, claim(s) 29-42 drawn to process of making compounds of formula III.

Group 5, claim(s) 43-50 drawn to process of making compounds of formula i.

Group 6, claim(s) 51-58 drawn to process of making compounds of formula ii.

Group 7, claim(s) 59-63 drawn to process of making compounds of formula iv.

Group 8, claim(s) 64-68 drawn to process of making compounds of formula viii.

Group 9, claim(s) 69-76 drawn to process of making compounds of formula i.

The inventions listed as Groups 1-3 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the structural moiety common to all the groups is not a contribution over prior art as this is found in the teachings of applicant cited reference of Gunasekera et al. (see specification page 1, last two lines).

To facilitate prosecution, Applicant is encouraged to amend the claims avoid rejection under USC 112 (first and second paragraph), relating to typographical and technical issues. **Examples** of such issues:

Claim 1, page 3 of 20,

Is the first structure, line 6, intended?

Claims 26/29, while deprotection using oxidizing agent is conceivable, the carbamate formation in the presence of 'hydrolyzing agent Al₂O₃' would require excessive imagination.

Claim 69, the definition of (X1)₂ is questionable. Note If a substituent is impossible, the claim can properly be rejected under 35 USC 112 paragraph 1 or 2. A compound with an impossible substituent clearly cannot be made, and hence a paragraph 1 rejection is proper. Alternatively, if it is impossible, then it is not correct.

Applicant is reminded of *In re Zletz*, 13 USPQ2d 1320, 1322. “An essential purpose of patent examination is to fashion claims that are precise, clear, correct and unambiguous.”

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIZAL S. CHANDRAKUMAR whose telephone number is (571)272-6202. The examiner can normally be reached on 8.30 AM - 4.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571 0272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nizal S. Chandrakumar

/D. Margaret Seaman/
Primary Examiner, Art Unit 1625